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REMARKS

Claims 1-25, 33-36, and 38-41 are pending in the present application. Claims 26-32 are withdrawn subject to a restriction requirement, and claim 37 is cancelled. New claims 39-41 have been added. Reconsideration of the application is respectfully requested in view of the following responsive remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the office action of April 27, 2007, the following actions were taken:

- (1) claims 10, 11, and 23 were rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement;
- (2) claims 1, 4, 6, 8, 9, 12, 13, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219;
- (3) claims 1, 4-6, 8-10, and 12-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357;
- (4) claims 1, 4-10, and 12-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357, in view of U.S. Published Application No. 2001/0039895 ("'895") and/or U.S. Patent No. 5,470,816 ("'816");
- (5) claims 1, 4-10, 12-15, 17, 20-22, 24, 25, 33, 35 and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357 in view of U.S. Patent No. 5,362,536 ("'536") or WIPO Published Application No. WO 03/032299 ("'299");
- (6) claims 1-10, and 12-16 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357 in view of U.S. Patent No. 2,957,004 ("'004") or U.S. Patent No. 4,284,704 ("'704");
- (7) claims 1-10, 12-22, 24, 25, 33-35 and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357, combined with either '004 or '704, in view of '536, or '299;
- (8) claims 1-10, 12-22, 24, 25, 33-36, and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219 and JP 58-008357, combined with either '004 or '704 in view of '536, or '299, further in view of U.S. Patent No. 4,508,811 ("'811") and Melles Griot Catalog (1995/96) pp. 49-4 through 49-5; and

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(9) Claims 1, 8, 9, 15, 11, 17, 22, 24-25, 33, 36, and 38 have been rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 7, 148, 182 in view of '536.

The Applicant assumes that all rejections not listed above, which did not appear in the office action dated April 27, 2007, have been withdrawn by the Examiner.

It is respectfully submitted that the presently pending claims be reconsidered and allowed. Applicants submit that each and every amendment herein, and throughout the prosecution of the present application is fully supported by the specification as originally filed, and that no new matter has been added.

Election/Restriction

The Examiner has again listed the restriction of claims as set forth in the previous office action. It is the Applicant's belief that an election has already been made and confirmed, however a request for confirmation is again set forth in this office action response. The Applicants again confirm the election of Group 1, namely claims 1-25, 33-36, and 38.

Obviousness-type Double Patenting

Claims 1, 8, 9, 15, 11, 17, 22, 24-25, 33, 36, and 38 have been rejected on the ground of non-statutory obviousness type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 7,148,182 in view of '536. Applicants include herewith a terminal disclaimer over U.S. 7,148,182. As such, it is respectfully requested that this rejection be withdrawn.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 10, 11, and 23 as allegedly failing to comply with the written description requirement. Specifically, the Examiner has rejected the phrase ethyl acetate and ethyl butyrate copolymer as allegedly lacking support in the originally filed specification. Pending claims 10, 11, and 23 have been amended to replace the disputed phrase with the phrase "cellulose acetate butyrate" as is described in Example 1 of the original application. Applicants assert that this

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amendment has literal support in the specification, and thus, withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected all of the presently pending claims over one or more references in combination. The Applicant respectfully submits that these claims are patentable over the cited references for the reasons set forth below, and that the rejection should be withdrawn.

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing the prior art reference, or references combined, teach or suggest all the claim limitations in the instant application. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in any of the rejections.

The RD 39219 Reference

Claims 1, 4, 6, 8, 9, 12, 13, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over RD 39219. RD 39219 introduces an imaging medium for thermal imaging applications with near infrared radiation. The medium includes 1,3-diiminoisoindoline and/or a related phthalocyanine precursor material, a thermally cleavable adduct capable of generating a phenolic compound with reducing properties, and a near infrared absorbing dye. RD 39219 also lists binders as a possible addition to the composition.

The independent claims (claims 1, 16, 17, and 33) from which all other noted claims depend have been amended to include the requirement of development in less than about 1 msec when exposed to about 30 mW to about 50 mW of infrared radiation by infrared radiation having a spot size which is within the range of 1 to 200 micrometers. In other words, the claims require that there be at least one spot size within the range of 1 to 200 micrometers where the development time be within 1 msec at 30 mW to about 50 mW. RD 39219 does not teach development in less than 1 msec under any conditions, let alone when exposed to about 30 mW to about 50

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mW of infrared radiation when applying at least one spot size within the range of from 1 to 200 micrometers.

The Examiner continues to assert that that the previously added limitations of power and duration added to the claims was not sufficient to overcome the prior art rejection of reference RD 39219 because a focused light allows the medium to be heated extremely efficiently. However, the Examiner does state that "were the applicant to include the spot size of the laser, the position would be stronger and perhaps convincing." Applicants have amended each of the independent claims to include a limitation of the spot size of the infrared radiation.

As asserted in the previous office actions, RD 39219 does not teach heating development in less than 1 msec under any conditions, let alone when exposed to about 30 mW to about 50 mW. Additionally, RD 39219 does not teach achieving such radiation amounts using a spot size within the range from 1 to 200 micrometers. As such, RD 39219 does not teach each and every element of the claims and therefore, the Applicant requests withdrawal of this rejection and allowance of the pending claims.

Combination Rejections

All other rejections are based on combinations of references using RD 39219 and/or JP 58-008357 as primary references in combination with or in view of other references. As RD 39219 has already been discussed, a brief discussion of JP 58-008357 is provided.

As discussed in the previous office action response, JP 58-008357 appears to be cumulative to RD 39219 with respect to relevant points. This reference is related primarily to a heat sensitive copying paper. In the specification, particularly the examples, the compositions are described as being heated to 150 °C, where color change was noted. Similar to RD 39219, JP 58-008358 does not seem to teach or suggest extremely fast development times as required by the currently pending claims. Nor does JP 58-008358 teach the use of an infrared radiation spot size within the range of about 1 to 200 micrometers.

This being stated, both of these references cited alone or in combination are deficient in their teachings for the same reasons discussed above with respect to RD 39219. As both RD 39219 and JP 58-008358 are the primary references for all of the

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current rejections, each rejections suffers from the same deficiencies described above. Further, no secondary reference seems to remedy this deficiency. As such, withdrawal of each of the present rejections is respectfully requested.

In view of the foregoing, Applicants believe that claims 1-25, 33-36 and 38-41 present allowable subject matter and allowance is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a telephone interview, the Examiner is invited to telephone the undersigned at (801) 566-6633 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 19th day of July, 2007.

Respectfully submitted,



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